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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,207	12/12/2003	Krishna Kishore Yellepeddy	AUS920010442US2	1768

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EXAMINER	
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ART UNIT	PAPER NUMBER
3628	

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02/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/735,207	YELLEPEDDY ET AL.	
	Examiner	Art Unit	
	Igor N. Borissov	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8,10-12,15,16,24,26,29 and 30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8, 10, 11, 12, 15, 16, 24, 26, 29 and 30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Amendment received on 12/03/2007 is acknowledged and entered. Claims 1-7, 9, 13, 14, 17-23, 25, 27, 28 and 31-37 have been canceled. Claims 8, 15, 16, 24, 26, 29 and 30 have been amended. Claims 8, 10, 11, 12, 15, 16, 24, 26, 29 and 30 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8, 10, 11, 15, 16, 24, 26, 29 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 8 Applicant has recited: "selecting an energy alternative that provides *optimal* energy usage,". But how can one know what the result of the optimization will be prior to actually running the numbers? One of skill in the art would have no way to know how "see into the future" and predict which energy alternative is optimal before the optimization has even been done? Undue experimentation would necessarily be involved and one of skill in the art would not be able to make and/or use the invention as claimed. Also lending to the non-enablement of the claim is the fact that it is not known what is meant by "optimal energy usage" (see 112,2). If you don't know what that term means, you cannot make the invention. Accordingly, Claims 8, 10, 11, 15, 16 are not enabled to one skilled in the art. Same reasoning applied to claims 24, 26, 29 and 30.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 10, 11, 15, 16, 24, 26, 29 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites: "selecting an energy alternative that provides *optimal* energy usage,", which is confusing. What is the scope of "*optimal* energy usage"? What does it mean to achieve the "*optimal* energy usage"? To optimize energy usage means one figures out an amount of energy necessary based on certain criteria of importance. The claim does not provide any indication which criteria was used and when said optimization has been conducted. Therefore, it is not clear what this claim is claiming. Same reasoning applied to claims 24, 26, 29 and 30.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8, 10, 11, 15, 16, 24, 26, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papalia et al. (US 6,255,805) in view of Neirlich et al. (US 6,519,509).

Papalia et all. (Papalia) teaches a computer-implemented method and computer-readable medium having computer-readable instructions for implementing said method for optimizing energy usage at an end user site comprising:

Independent Claims

Claims 8 and 24,

determining a cost for generating energy at the end user site;

determining the cost of purchasing energy from another energy supplier;

establishing a set of end-user energy policies for generating and using energy at the end-user facility; and

generating a set of energy supply alternatives based on the energy user requirements and the cost of the energy alternatives (C. 2, L. 32 – C. 3, L. 20);

selecting an energy alternative that provides optimal energy usage, said selection being based on said established end-user energy policies;

generating energy at the end-user facility, and using said generated energy as desired by the end-user; and

selling any excess generated energy to other end-users or to energy suppliers by making said information about available energy available to potential energy purchasers thereby indicating "consummating" step (C. 2, L. 32 – C. 3, L. 20).

While Papalia teaches conducting energy trades in the open market, thereby suggesting placing information about available energy in a location accessible to potential energy purchasers, and negotiating the price and quantity of the energy with a potential energy purchaser, Papalia does not explicitly discloses specifics of said trades.

Neirlich et al. (Neirlich) teaches a computer-implemented method and computer-readable medium having computer-readable instructions for implementing said method for optimizing energy usage at an end user site, wherein end-users can activate private energy generators for personal use when buying energy from energy providers is not feasible, and wherein the excess of said energy generated at the end-users premises can be sold to potential energy purchasers, and further wherein various specifics of open market trade are disclosed including placing information about available energy in a location accessible to potential energy purchasers; negotiating the price and quantity of the energy with a potential energy purchaser; said information containing a desired

energy quantity and purchase price; determining whether to accept the offer, reject the offer or to submit a counter offer to the potential purchaser; and submitting a response to the potential energy purchaser, thereby consummating the transaction with the potential energy purchaser (Figs. 12, 13, 19-23; C. 2, L. 51-60; C. 4, L. 23-24; C. 8, L. 25-45; C. 9, L. 23-63; C. 10, L. 43-46; C. 11, L. 21-23; C. 16, L. 35-37).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Papalia to include specifics of conducting energy trades in the open market, as disclosed in Neirlich, because it would advantageously allow to enable monitoring, control, and analysis of load profiles and energy market prices that cover a large number of distributed end-users, as specifically stated in Neirlich (C. 17, L. 5-7). Furthermore, in this case, each of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. *See Sakraida,* 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision Ex arte Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Dependent Claims

Claims 10-12, 26, 29 and 30, same reasoning as applied to claims 8 and 24.

Response to Arguments

Applicant's arguments filed 12/05/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art fails to disclose: selecting an energy alternative that provides optimal energy usage based on said established end-user energy policies, it is noted that Papalia explicitly teaches that (C. 2, L. 42-54):

> The source sharing control circuit 110 receives information from an external data source 130. The data source 130 could include an aggregator 132, a data input from the electric meter 104 and a data input from the gas meter 106. An aggregator 132 is an entity that **provides data regarding the economic costs involved in receiving power from the power grid 102 and in generating power from the generator 142.** For example, the aggregator 132 could provide the current price of electric power and the current price of fuel (e.g. natural gas) for the generator. The aggregator 132, in one embodiment could simply **provide a binary indication of whether current price conditions favor local power generation versus taking power from the grid** 102.

It is clear from this paragraph that Papalia's power obtained from the grid or from the generator corresponds to energy alternatives; and the least cost scenario corresponds to optimal energy usage based on said established end-user energy policies.

In response to applicant's argument that the prior art fails to disclose: selling any excess generated energy to other end-users or to energy suppliers by placing information about available energy in a location accessible to potential energy purchasers, it is noted that Papalia teaches an open market environment wherein an excess of generated energy is sold back to the grid (C. 5, L. 22-26), thereby suggesting making available information regarding said generated energy to the market participants. Furthermore, Nierlich et al. discloses this feature in details (see a discussion above).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/
Primary Examiner, Art Unit 3628
02/05/2008

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